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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/717,255

11/19/2003

Kent D. Rager

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EXAMINER

CUMMING, WILLIAM D

ART UNIT

PAPER NUMBER

2617

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/717,255	Applicant(s) RAGER & OTTING	
	Examiner WILLIAM D. CUMMING	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12, 14-16, 19, and 20 is/are rejected.
- 7) ☒ Claim(s) 3-11, 13, 17, 18 and 21-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 2, 12, 14-16, 19, and 20, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Keshavachar, et al.**

Regarding claims 1, 12, 14, 19 and 20, **Keshavacher, et al** a method in a wireless communications device (*"The present invention relates generally to cellular telephones, and more particularly to a system and method for optimizing the rate at which a mobile station telephone conducts a search for its home network."*), the method comprising: operating in a network other than a home network of the wireless communications device (*"It is desirable that the mobile station user communicates through their HPLMN. The cost of making calls through the network is known when a mobile station is connected to other users through the HPLMN. When the mobile station uses other PLMNs charges may vary, and the user may be unaware of higher costs as the call is being made. The HPLMN may also offer special services to its subscribers that are unavailable on other PLMNs. Such services include call forwarding and call barring. It is possible the mobile station, as it travels, will acquire another PLMN, other than the HPLMN, and remain with this network long after the mobile station has moved back within range of the HPLMN. As a result, mobile stations may*

*visit PLMNs that are not the HPLMN more often than is necessary.")Determining whether to search for the home network of the wireless communications device when not operating in the home network by comparing network record information associated with the network in which the mobile wireless communications device is operating to reference information ("In step 108 the mobile station determines whether the network selected is the HPLMN. If, in step 108, the HPLMN has been located, the process continues to a step 110 in which the mobile station locks on to, or "camps", on the PLMN it has selected. The mobile station continues to be camped on the PLMN until a loss of signal occurs in step 112. A loss of signal occurs when the mobile station is unable to adequately communicate through any of the cells in the selected PLMN. When a loss of signal occurs the process returns to step 100 to search for a suitable network.")*

Regarding claims 2 and 15, Keshavachar, et al discloses *"In addition to searching for proximate cells, the mobile station also makes searches for its Home Public Land Mobile Network (HPLMN). The HPLMN is the network with which the mobile user has a subscription relationship, the network with which the mobile user prefers to do business. In the automatic network selection mode the mobile station automatically attempts to select and register with the HPLMN. In the manual network selection mode the HPLMN is usually one of several selectable PLMNs. Examples of cellular phone systems requiring a HPLMN search are the Global System for Mobile Communications (GSM) System,*

*Personal Communications Service at 1900 Mhz (PCS 1900), and the Digital Cellular System at 1800 Mhz (DCS 1800). More details of the GSM system can be found in the text, "The GSM System for Mobile Communications" by Michel Mouly and Marie-Bernadette Paulet, Mouly and Paulet, 1992.*

*GSM cellular phone systems are operated in accordance with a set of comprehensive specifications. GSM 02.11 of the European Telecommunications Standard for GSM cellular telephones specifies that the mobile station shall make attempts to return to its HPLMN when visiting another PLMN. A value of 30 minutes between home network searches is listed in the specification. The specification also includes a note warning that use of values of less than 30 minutes may result in excessive battery drain."*

### ***Response to Arguments***

3. Applicant's arguments filed August 3, 2006 have been fully considered but they are not persuasive.

Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "inherent" or otherwise implicit in relevant reference (Standard Havens Products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321). During examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the

claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). In response to Applicant's argument, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. It was held in In re Donohue, 226 USPQ 619, that, "It is well settled that prior art under 35 USC §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it...Such possession is effected if one of ordinary skill in the art could have combine the description of the invention with his own knowledge to make the claimed invention." Clear inference to the artisan must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome "heavy presumption" that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Applicant always has

the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). "Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." Twin Disc, Inc. v. United States, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting In re Self, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998).

**Keshavacher** clearly disclose determining whether to search for the home network of the wireless communications device when not operating in the home network by comparing network record information associated with the network in which the mobile wireless communications device is operating to reference information, not again the above and figure 6A, #118, 120, 122, figure 6B, #98-114, figure 6C, 106, 110, 116.

If Applicants claim their invention in such overly broad terms that it should not come to surprise to the Applicants that the examiner examines the claims just as broadly.

***Allowable Subject Matter***

4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).
5. Claims 3-11, 13, 17, 18, and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



8. If applicants wish to request for an interview, an "Applicant Initiated Interview Request" form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed "Applicant Initiated Interview Request" form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

9. If applicants request an interview after this final rejection, prior to the interview, the intended purpose and content of the interview should be presented briefly, in writing.


Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration.

Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM D. CUMMING whose telephone number is 571-272-7861. The examiner can normally be reached on Monday-Thursday 11am-8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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